

REMARKS

In response to the final Office Action mailed April 10, 2006, the applicants respectfully request reconsideration. In the Office Action, claims 1-5, 7-10, 12-17 and 19-23 were rejected and claims 6, 11 and 18 were objected to. By this amendment, claim 13 has been amended. Accordingly, claims 1-22 are pending in the application.

Claim Rejections Under 35 U.S.C. §103

Claims 1-5, 7-10, 12-17 and 19-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Maxim Data Sheet 19-2735, Rev 0, 1/03 in view of Suessmilch. This rejection is respectfully traversed, as the combination relied upon by the examiner is not proper under 35 U.S.C. §103.

The Maxim Data Sheet teaches an ORing MOSFET controller that provides fault isolation for redundant power supplies by providing a reverse current detection feature. Suessmilch teaches an overcurrent protective circuit. There is no teaching or suggestion in the Maxim Data Sheet of the need or desirability to include a second controller which, based on certain characteristics of the device, acts to control the first controller to cause the first controller to perform a particular function. Further, there is no teaching or suggestion in Suessmilch of the need or desirability to use the output of the device to do anything but directly control the operation of a switch.

The examiner states that it would have been obvious to one of ordinary skill in the art to combine the teachings of Maxim and Suessmilch by driving the FET of Maxim with the output of the circuit of Suessmilch. However, the examiner provides no evidence in the prior art that suggests the desirability of the claimed invention. See MPEP §2143.01:

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). *The level of skill in the art cannot be relied upon to provide the suggestion to combine references.*

Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999)(Emphasis added).

As set forth by the Federal Circuit, “In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the Examiner to provide a ‘clear and particular’ showing of ‘actual evidence’ of a suggestion, teaching, or motivation to combine references.” In re Dembiczak, 50 USPQ 2d, 1614, 1617 (Fed. Cir. 1999). “Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence.” Id., citing McElmury v. Arkansas Power and Light Co., 995 F.2d 1576, 1578, 27 USPQ2d. 1129, 1131 (Fed. Cir. 1993). (internal quotations omitted).

In fact, in In re Dembiczak, the Court of Appeals for the Federal Circuit recognized that “rigorous application” of the requirement for a showing of a teaching or motivation to combine references is the “best defense against the subtle but powerful attraction” of improper hindsight-based obvious analysis. Id.; See also, Para-Ordnance Manufacturing, Inc. v. SGS Importers International, Inc., 73 F.3d 1085, 37 USPQ2d 1237 (Fed. Cir. 1995). (“obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor”). This is especially true in cases where the ease with which the invention may be understood “may prompt one to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher.” Id. citing W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Clearly, since there is no teaching or suggestion of the desirability of the claimed invention in either of the references, and the examiner has not provided any such evidence, the only source of the desirability is the applicants’ specification. Consequently, the combination is a result of improper hindsight reasoning, which, as set forth above, is not permissible under 35 U.S.C. §103.

Regarding the examiner’s citation of Shi, applicants assert that Shi teaches separate and independent devices for overcurrent protection and reverse current protection. Accordingly, Shi does not provide the required motivation lacked by Maxim and Suessmilch for the combination relied upon by the examiner.

Therefore, because the combination relied upon by the examiner is improper, claims 1-5, 7-10, 12-17 and 19-22 are allowable and the rejection of claims 1-5, 7-10, 12-17 and 19-22 under 35 U.S.C. §103 should be withdrawn.

Allowable Subject Matter

Applicants acknowledge and appreciate the examiners indication that claims 6, 11 and 18 would be allowable if rewritten in independent form. However, since the claims from which these claims depend are allowable, applicant asserts that amending these claims is not necessary.

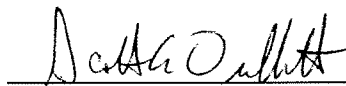
Based on the foregoing, applicants respectfully assert that claims 1-22 are allowable over the art of record and respectfully request that a timely Notice of Allowance be issued in this application.

In the event the Patent Office deems personal contact desirable in disposition of this matter, the Office is invited to contact the undersigned attorney at (508) 293-7835.

Please charge any fees occasioned by this submission to Deposit Account No. 05-0889.

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Respectfully submitted,



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